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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,001	01/16/2004	Eugenio Cruz Garcia	5724.012.21-US	5034
30827 7590 08/31/2009 MCKENNA LONG & ALDRIDGE LLP 1900 K STREET, NW WASHINGTON, DC 20006				
EXAMINER				
LAUX, JESSICA L				
ART UNIT		PAPER NUMBER		
3635				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/758,001

Applicant(s)

GARCIA, EUGENIO CRUZ

Examiner

JESSICA LAUX

Art Unit

3635

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-08)
Paper No(s)/Mail Date 8/7/2009.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 1/12/2009 have been fully considered but they are not persuasive.

Piacente clearly and expressly discloses and teaches a surface texture that varies in accordance with a visual pattern, reference to Col. 2, line 66 – Col. 3, line 3 and Col. 3, lines 26-28 where both individually disclose having a surface texture in register with a visual pattern. While those passages do not expressly disclose what the image of the visual pattern is Piacente clearly discloses in Col 1, lines 53-57 that it is known to have a visual pattern that imitates another product. The fact that such a disclose is included as what is common and known in the art does not mean Piacente does not provide a clearly teaching of such. Applicant's argument that such a teaching refers to "common practice" and the invention of Piacente teaches way from "common practice" is not persuasive as the purpose of Piacente is to provide an improved or alternate method of achieving the desired visual effect, not to change what the visual effect is. Therefore, one of ordinary skill in the art would be motivated by a review and understanding of Piacente to provide a surface texture that varies in accordance with a visual pattern where the visual pattern imitates another product.

In response to applicant's argument that it is not possible to combine Piacente and Martensson to achieve the claimed laminate floor boards, it is noted that Piacente is not relied upon for its teaching of the method of embossing, but rather for the teaching of embossing in register with a visual pattern. Additionally it is noted that there are a

wide variety of techniques for embossing, each more suitable to specific materials than others. One of ordinary skill in the art upon review of the cited references would be motivated to pursue known embossing techniques to achieve a laminate floor (as claimed and disclosed by Martensson) to have a surface embossed in accordance with a visual pattern (as disclosed by Piacente).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification is not enabling for edge contours that are "pressed below the interior region".

Claims 14-15, 18-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not teach, suggest or disclose an edge contour that has a substantially linear shape, or a substantially continuous curve from the interior region to an edge of the product.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the edge contour with substantially continuous curve must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martensson (6146252) in view of Piacente et al (5858160).

Claims 13-19: Martensson discloses a laminated material comprising at least one cellulose sheet impregnated with resin that is mechanically pressed and cut into a product (Col. 3, lines 21-44 and claims 15-19) said product having a fiberboard core (col. 1, lines 14-20). The product includes a surface with a machined edged contour (14 and 18, Figure 2 and Col. 1, lines 21-28) and an interior region (top surface of 13, Figure 2), where in the edge contour lies below the interior region. While the edge contour is shown to have a substantially linear cross-sectional shape from the interior region to an edge of the product (14, Figure 2), Martensson discloses that the edge contour may also have smooth edges, as in forming curved grooves and tenons for floor boards that are joined side by side (Col. 1, lines 21-28). The laminate also comprises one patterned sheet (Col. 3, lines 26-28). Since the patterned sheet is laminated as a layer of the product prior to edge contouring, the pattern will not extend into the edge contour.

Martensson does not disclose the laminated material to have a surface texture that varies in accordance with a visual pattern that imitates another product. Piacente et al. discloses a panel for flooring that has a surface texture that varies in accordance with a visual pattern that imitates another product (Col. 3, lines 26-28; Col. 2, line 66 – Col. 3, line 3; Col. 1, lines 53-57).

In view of Piacente et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the top surface of Martensson's floor

panel with impressions that follow the underlying décor to enhance the realistic effect of the décor.

It should be noted that the limitations “mechanically pressed and cut into a product” and “has been pressed below” are considered product-by-process limitations. The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985). In the instant case the claimed invention is the same as or obvious from a product of the prior art, where the prior art discloses a cut product having edge contours below the interior region, even though the prior product may have been made by a different process.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA LAUX whose telephone number is (571)272-8228. The examiner can normally be reached on Monday thru Thursday, 9:00am to 5:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot, Jr./
Supervisory Patent Examiner, Art Unit 3635

/J. L./
Examiner, Art Unit 3635